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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,820	02/08/2002	David Coleman		6294

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EXAMINER

SAADAT, CAMERON

ART UNIT PAPER NUMBER

3713

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/072,820	<b>Applicant(s)</b> COLEMAN ET AL.	
	<b>Examiner</b> Cameron Saadat	<b>Art Unit</b> 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THE COMMUNICATION. MAILED ON 6/17/2005.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 26-30, 47-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **SUPPLEMENTAL DETAILED ACTION**

In response to amendment filed 2/16/2005, claims 1-67 are pending in this application. This supplemental action addresses applicant's remarks filed 9/7/2004 and 2/15/2005.

#### ***Election/Restrictions***

Newly submitted claims 6-25, 31-46, and 52-67 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons: Original claims 1-5 and similar new claims 26-30 and 47-51 are drawn to a method and system for processing test results (Class 434/353). New claims 6-7 are drawn to a method of implementing a procedure wherein an expert determines a user's skill level (Class 705/11); claims 8-9, 13, 31-32, 36, 52-53, and 57 are drawn to a method and system for generating evaluative or formative statements (Class 434/347); claims 10-12, 33-35, 54-56 are drawn to a method and system for calculating a test taker's growth potential (Class 705/11); claims 14, 37, and 58 are drawn to a method of choosing an instructional approach (434/236); claims 16-25, 38-46, and 59-67 are drawn to an interface for displaying results (345/700). The inventions are prima facie independent and distinct inventions due to their recitations of distinct and specific structures.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 6-25, 31-46, and 52-67 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-5, 26-30, and 47-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Geshwind (US Patent Application Publication 2002/0052860 A1).**

Regarding claims 1, 26, and 47, Geshwind discloses a method for processing and displaying test results of one or more tests taken by a plurality of test takers, the method comprising the steps of: obtaining a test having a plurality of items and obtaining the item responses of test takers; determining appropriate skill categories necessary for a correct response for each of the items, in order to report each test takers' skill-specific performance on the test (see ¶ 54); assessing the extent to which each item on the test assesses one or more of the skills determined (see ¶ 52); and calculating a score for each student's performance in each skill category (See Fig. 5; ¶ 56).

Regarding claims 2, 27, and 48, Geshwind discloses a method, further comprising a step 728 of calculating the scores of a group of test takers for each question having a specific skill category (see ¶ 56).

Regarding claims 3, 28, and 49, Geshwind discloses a method, further comprising the step of generating evaluation and formative statements for individual test-takers and groups (¶'s 54-55).

Regarding claims 4, 29, and 50, Geshwind discloses a method, further comprising the step of organizing instructional material based on the content of the test (see ¶ 53).

Regarding claim 5, 30, and 51, Geshwind discloses a method, further comprising the step of displaying test results and instructional material to individuals (see ¶ 58).

*Response to Arguments*

Applicant's arguments filed 2/16/2005 with respect to claims 26 and 47 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant merely recites the claims and purports that Geshwind has no corresponding teaching or disclosure.

Applicant's arguments filed 9/7/2004 has been fully considered but they are not persuasive. Applicant purports that Geshwind does not disclose or suggest the features of claims 1, 26, and 47. The examiner disagrees. Geshwind discloses a method for processing and displaying test results of one or more tests taken by a plurality of test takers, comprising steps of: obtaining a test having a plurality of items and obtaining the item responses of test takers; determining appropriate skill categories necessary for a correct response for each of the items, in order to report each test takers' skill-specific performance on the test (see ¶ 54); assessing the extent to which each item on the test assesses one or more of the skills determined (see ¶ 52); and calculating a score for each student's performance in each skill category (See Fig. 5; ¶ 56).

It is further purported that Geshwind does not disclose or suggest the features of calculating the scores of a group of test takers for each question having a specific skill category; and generating evaluation and formative statements. The examiner disagrees. Geshwind clearly discloses a step of calculating scores for a group of test takers for a particular question having a specific skill category (see ¶ 56); and generating evaluation and formative statements (see ¶'s 54-55).

Applicant additionally emphasizes that Figures 10-19 and paragraphs 64-151 of the Geshwind publication are not part of the Geshwind provisional application, and therefore are not entitled to the provisional filing date. The examiner agrees. However, it is noted that figures 1-9 and paragraphs 31-63 of the Geshwind publication are fully supported on pages 1-14 of the Geshwind provisional application, and are therefore entitled to the provisional filing date. The subject matter described in applicant's claims 1-5, 26-30, and 47-51 are anticipated by Geshwind in figures 1-9 and paragraphs 31-63.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is (571) 272-4443. The examiner can normally be reached on M-F 9:00 - 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cameron Saadat  
August 29, 2005



**XUAN M. THAI**  
**SUPERVISORY PATENT EXAMINER**  
TC3760